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3 **RESPONSE UNDER 37 C.F.R. § 1.116**  
**EXPEDITED PROCEDURE – Art Unit 2652**  
Attorney Docket No. 54600-8130.US00

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1/10/2003

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By: Susan L. Baka  
Susan L. Baka

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF: Lim, et al.  
APPLICATION No.: 09/518,297  
FILED: March 3, 2000  
FOR: **DNA BINDING COMPOUND-MEDIATED MOLECULAR SWITCH SYSTEM**

EXAMINER: Kam, Chih Min  
ART UNIT: 1653  
CONF. NO: 5390

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**Amendment Under 37 C.F.R. § 1.116**

Box AF  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

1. Transmitted herewith are the following:

- ☒ A Response/Amendment Under 37 CFR 1.116 (After Final)
- ☒ A Petition for 3-Month Extension of Time
- ☒ A Notice of Appeal with Petition for 3-Month Extension of Time
- ☐ A Terminal Disclaimer
- ☐ Sequence Listing printout, floppy diskette, matching declaration
- ☐ Information Disclosure Statement, Form 1449, References
- ☒ Check in the amount of \$625

2. Entity Status

- ☒ Small Entity Status (37 CFR 1.9 and 1.27) has been established by a previously submitted Small Entity Statement.

3. Conditional Petition for Extension of Time

An Extension of Time is requested to provide for timely filing if necessary for timely filing of this transmittal and enclosures.

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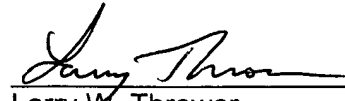
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4. Provisional Fee Authorization

Please charge any underpayment in fees for timely filing of this transmittal and enclosures to Deposit Account No. 50-2207.

Respectfully submitted,  
Perkins Coie LLP

Date: 1-10-03

  
Larry W. Thrower  
Registration No. 47,994

**Correspondence Address:**

Customer No. 22918  
Perkins Coie LLP  
P.O. Box 2168  
Menlo Park, California 94026  
(650) 838-4300



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Date: 1-10-2003

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DOCKET No.: 54600.8130.US00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF:

Lim et al.

SERIAL NO.: 09/518,297

FILED: March 3, 2000

FOR: DNA BINDING COMPOUND-MEDIATED  
MOLECULAR SWITCH SYSTEM

EXAMINER: Chih-Min Kam

ART UNIT: 1643

**Response Under 37 C.F.R. §1.116**

Box AF  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Reconsideration of the rejection set forth in the Office Action dated July 12, 2002 is respectfully requested. Applicants petition the Commissioner for a 3-month extension of time. A separate petition and a Notice of Appeal accompany this response. Claims 1-19 and 21-30 are currently under examination.

**I. Rejection Under 35 U.S.C. §112, Second Paragraph**

Claims 1-19 and 21-30 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. This rejection is traversed in view of the following.

The Examiner asserts the term "a non-native compound binding sequence which is the same as, overlapping, or adjacent to said DNA response element for binding to a DNA binding compound" renders the claims indefinite because "it is unclear how a non-native compound

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binding sequence which is introduced to the DNA construct can be the same as the DNA binding element for a transcriptional regulatory protein.”

In rejecting a claim under the second paragraph of 35 U.S.C. 112, it is incumbent on the Examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. *Ex parte Wu*, 10 USPQ 2d 2031, 2033 (B.P.A.I. 1989). Applicants fail to see how a non-native compound binding sequence cannot be the same as the DNA response element. There is no requirement that the DNA response element be native. Thus, if the non-native compound binding sequence is the same as the DNA response element, then the DNA response element is a non-native compound binding sequence.

The Examiner is directed to page 10, lines 12-14 of the specification, which defines the term “DNA response element” as the DNA binding site or sequence for a transcriptional regulatory protein, which may be the same as, overlapping, or adjacent to, a compound-binding sequence. Page 18, lines 1-8 describe an embodiment of the invention comprising a synthetic DNA response element which has been introduced into cells. As explicitly stated on line 6, the compound-binding sequence may be the same as the DNA response element.

Thus, Applicants submit that: (i) the Examiner has not provided any reasoning as to why the claim is unclear when read in view of the specification, and (ii) when read in light of the supporting specification, the phrase “a non-native compound binding sequence which is the same as, overlapping, or adjacent to said DNA response element for binding to a DNA binding compound” is sufficiently definite.

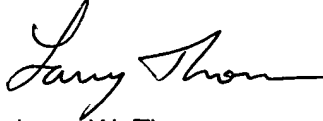
Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §112, second paragraph.

## II. Conclusion

In view of the above remarks, Applicants submit that the pending claims are in condition for allowance. A Notice of Allowance is, therefore, respectfully requested.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 838-4405.

Respectfully submitted,



Larry W. Thrower  
Registration No. 47,994

Date: 1-10-03

**Correspondence Address**

Tel: (650) 838-4300  
Customer No. 22918